



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Jean MONDET et al.

Application No.: 09/511,073

Filed: February 23, 2000

Group Art Unit: 1711

Examiner: R. Sergeant

Docket No.: WPB 29683C

GROUP 1700

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For: NEW POLYESTER POLYURETHANES, PROCESS FOR PREPARING THEM,
PSEUDOLATICES PRODUCED FROM THE SAID POLYESTER
POLYURETHANES AND THEIR USE IN COSMETIC COMPOSITIONS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the June 4, 2003 Quayle Action, reconsideration of the requirement of cancellation of non-elected claims 41-49 and 71-79, and rejoinder and allowance of these non-elected claims, are respectfully requested in light of the following remarks.

I. The Basis for Restriction was Improper, and the Restriction Should be Withdrawn

Allowed claims 20-40 and 50-70 are directed to a stable pseudolatex, while non-elected claims 41-49 and 71-79 are directed to a cosmetic composition comprising the pseudolatex. Specifically, non-elected claims 41 and 71 read:

41. Cosmetic composition comprising the pseudolatex according to claim 20 in a cosmetic carrier.

71. Cosmetic composition comprising the pseudolatex according to claim 50 in a cosmetic carrier.

In the original Restriction Requirement, it was alleged that the pseudolatex and the cosmetic composition were related as mutually exclusive species in an intermediate (the pseudolatex) - final product (the cosmetic composition) relationship.

However, Applicants respectfully submit that the characterization of the relationship between the claims as being intermediate-final product is not accurate. An intermediate, as that term is used in MPEP §806.04(b), is intended to refer to a chemical material that undergoes a reaction to derive a final chemical material. For example, the MPEP specifically states that typically, the intermediate loses its identity in the final product. In this regard, characterizing the pseudolatex as an intermediate and the cosmetic composition as a final product is not accurate.

Instead, the pseudolatex and cosmetic composition are related as subcombination (the pseudolatex) and combination (the cosmetic composition). See MPEP §806.05(a), indicating that a combination is an organization of which a subcombination is a part. This properly characterizes the relationship between the pseudolatex and the cosmetic composition, as the cosmetic composition is an organization of which the pseudolatex is a part.

For restriction to be proper in a combination-subcombination relationship, it must be established that a combination as claimed (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination has utility either by itself or in other and different relations. When both of these factors cannot be shown, restriction should not be required. See MPEP §806.05(c). In the present case, factor (A) cannot be established.

That is, the non-elected claims are directed to a combination (the cosmetic composition) that relies upon essential features of the subcombination (the pseudolatex) for patentability. In accordance with MPEP §806.05(c)II, restriction should not be required

because the patentability of the combination depends solely upon the features of the subcombination.

Accordingly, reconsideration of the requirement of cancellation of claims 41-49 and 71-79, and rejoinder and allowance of these non-elected claims, are respectfully requested.

II. Rejoinder is Appropriate

Where the non-elected claims depend from and fully incorporate all limitations of the elected and allowed claims, rejoinder is appropriate. This is particularly true in the present case where the non-elected claims essentially define a particular use of the subject matter of the elected and allowed claims. See MPEP §821.04 for a general discussion of rejoinder. From this discussion, it is evident that it is more appropriate to rejoin the claims directed to the cosmetic composition rather than to require a separate divisional application to be filed directed to this subject matter since, here again, the patentability of the cosmetic composition claims depends solely upon the patentability of the allowed pseudolatex claims.

Finally, MPEP §806.05(c)III also indicates that even if restriction among a subcombination-combination was initially believed appropriate, it should nevertheless be revisited upon allowance of claims to the subcombination to determine if rejoinder of the non-elected combination claims should be made. Applicants submit that rejoinder is proper for all the reasons discussed above, and should be made.

Accordingly, reconsideration of the requirement of cancellation of claims 41-49 and 71-79, and rejoinder and allowance of these non-elected claims, are respectfully requested.

III. Conclusion

For all the foregoing reasons, Applicants respectfully submit that claims 41-49 and 71-79 should be rejoined with the application and allowed along with claims 20-40 and 50-70. Thus, reconsideration and withdrawal of the requirement of cancellation of non-elected

claims 41-49 and 71-79, and allowance of these claims, are respectfully requested. Favorable reconsideration and prompt allowance of claims 20-79 are accordingly earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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